



Patent
Attorney's Docket No. 017753-160

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Gilles CAUET et al.) Group Art Unit: 1616
Application No.: 10/089,803) Examiner: Delia M. Ramirez
Filed: July 22, 2002) Confirmation No.: 2729
For: METHOD FOR PREPARING STEROIDS)
MODIFIED BY YEAST)
FERMENTATION)

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AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a Response to Restriction Requirement for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ A Terminal Disclaimer and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are _____.
- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted ___, on ___, for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least ___, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

(10/03)

- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.
- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below:

AMENDED CLAIMS					
	NO. OF CLAIMS	HIGHEST NO. OF CLAIMS PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	ADD'L FEE
Total Claims		MINUS =		× \$18.00 (1202) =	
Independent Claims		MINUS =		× \$86.00 (1201) =	
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					0
If small entity status is claimed, subtract 50% of Total Claim Amendment Fee					
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					0

☐ A check in the amount of \$ _____ is enclosed for the fee due.

☐ Charge \$ _____ to Deposit Account No. 02-4800.


The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: November 12, 2003

By:


Jennifer A. Topmiller, Ph.D.
Registration No. 50,435

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Office Action [Restriction Requirement] mailed October 15 2003, Applicants hereby elect, albeit with traverse, Group I, Claims 17-30 and 32, drawn to a method for producing hydroxylated and/or acetylated steroids with yeast transformed to express the Cyp7b gene and a yeast cell transformed to express the Cyp7b gene.

Applicants respectfully submit that unity of invention does exist with respect to Groups I and II and between Groups I and II. Claim 31 of Group II is drawn to a yeast with zero 17-dehydrogenase activity by inactivation of the *yii124w* gene. Claims 27 and 28 of Group I are directed towards yeast with varying levels of 17-dehydrogenase activity, include zero activity, and where the 17-dehydrogenase activity is carried by the *yii124w*

gene. Thus, Applicants respectfully submit that unity of invention exists between Groups I and II.

Applicants also submit that Groups I and III possess unity of invention. Specifically, the method of Claim 33 of Group II is merely a use for the method of Group I and, in depending from Claim 17 of Group I, necessarily uses the steps of Claim 17 of Group I. Accordingly, unity of invention exists between Group I and III. Additionally, because Claim 33 depends on Claim 17, the search necessarily to completely examine Group I would necessarily substantially overlap that needed to completely examine Group III. Thus, such a search would not be unduly burdensome for the Examiner. Applicants therefore request rejoinder of Claim 33 with the claims of elected Group I.

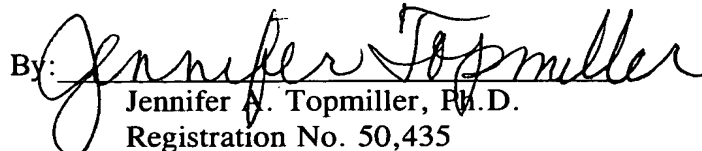
Applicants respectfully request rejoinder of all groups and examination of all claims on the merits at this time..

If there are any questions concerning this reply, or the application in general, the Examiner is respectfully requested to telephone Applicant's undersigned representative so that prosecution may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: November 12, 2003

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